



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/327,594 06/08/99 DEMIRYONT

H 03897.08139

IM52/1011  
PETER D MCDERMOTT  
BANNER & WITCOFF LTD  
28 STATE STREET 28TH FLOOR  
BOSTON MA 02109

EXAMINER

MCNEIL, J

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**BEST AVAILABLE COPY**

# Office Action Summary

Application No.

09/327,594

Applicant(s)

Demiryont, Huyla

Examiner

Jennifer McNell

Art Unit

1775



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Jul 20, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-16 is/are pending in the application

4a) Of the above, claim(s) 15 and 16 is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-14 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

20) ☐ Other:

Art Unit: 1775

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1, 2, 5, and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al (US 5,213,842). Brown et al teach a glass substrate with a  $\text{SnO}_2\cdot\text{F}$  coating which is subsequently coated with a copper oxide film. While the layer of  $\text{SnO}_2\cdot\text{F}$  is not referred to as a coloration layer, it is comprised of  $\text{SnO}_2$  and therefore is considered to impart the same properties claimed by applicant. Brown et al do not teach application of the layer by sputtering. With regard to the limitation of sputtering, "Even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966. Once the examiner provides a rationale tending to show that the claimed

Art Unit: 1775

product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F. 2d 798, 802, 218, USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

3. Claims 1, and 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Breininger et al (US 4,170,461). Breininger et al teach a glass substrate with a film of copper oxide applied thereto. The glass may be a clear soda-lime-glass. Deposition of the cuprous oxide film provides a coated glass article which appears blue-green at the film surface, yellow-green at the glass surface, and greenish by transmission. Regarding the limitation of sputtering, please see the statement in paragraph 2.

4. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyauchi et al (US 5942,331). Miyauchi et al teach a colored film coated glass article including a soda lime silicate glass substrate with light green coloration, and a film applied thereto which may comprise 5-95% copper oxide colorant. The glass substrate is preferably used as a glass plate for automobile windows. The film thickness may be 60-200 nm which corresponds to 600-2000 angstroms. (Col. 6, lines 23-34; Regarding the language "consisting essentially of sputter coated copper oxide", the additional components of the film are not considered to alter the general properties of the film. Regarding the limitation of sputtering, please see the statement in paragraph 2.

Art Unit: 1775

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyauchi et al (US 5,942,331) in view of Kobrehel et al (US 5,915,780). Miyauchi et al teach a colored film coated glass article used for automotive windows as discussed above but do not teach the specific shape of the plate to be used for the window. Kobrehel et al teach a glazed window module for automotive use and disclose that "Glass window modules commonly used in the automotive industry typically comprise a sheet of glass, often bent into a curvo-planar shape..." (col. 1, lines 11-13). As it is taught by Kobrehel et al that automotive glass windows commonly have a curvo-planar shape, it would have been obvious to one of ordinary skill in the art to impart this shape to the automotive glass plate of Miyauchi et al.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US 5,213,842). Brown et al teach a glass substrate coated with a layer of  $\text{SnO}_2\cdot\text{F}$  and a layer of copper oxide as discussed above and also disclose that the copper oxide layer has a thickness of about 800 angstroms. Brown et al do not teach the thickness of the layer of  $\text{SnO}_2\cdot\text{F}$ . Absent a showing of criticality, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a layer of  $\text{SnO}_2\cdot\text{F}$  at an appropriate thickness, since it has

Art Unit: 1775

been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, and 2-7 over Breininger et al have been considered but are moot in view of the new ground(s) of rejection. Applicant amended the claim to reflect the method limitation of sputtering. This limitation is not considered to impact the final structure of the article and therefore does not patentably distinguish it from the prior art of record.

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection over Brown et al, Miyauchi et al, and Kobrehel et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer McNeil whose telephone number is (703) 305-0553. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached at (703) 308-3822.

When filing a fax in Group 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of this application. This will

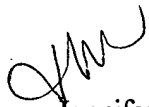
Application/Control Number: 09/327594

Page 6

Art Unit: 1775

expedite processing of your papers. The fax number for this Group are (703) 305-3599 for "Official" faxes and (703) 3055436 for "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0661.



Jennifer McNeil  
Patent Examiner  
AU 1775



DEBORAH JONES  
SUPERVISORY PATENT EXAMINER